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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/987,338

11/14/2001

William Charles Lynch

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12/19/2002

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EXAMINER

NGUYEN, THUAN T

ART UNIT

PAPER NUMBER

2684

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/987,338

Applicant(s)
Lynch

Examiner
Thuan Nguyen

Art Unit
2684



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-138 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-138 is/are rejected.
- 7) ☒ Claim(s) 19-138 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Nov 14, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 2746

DETAILED ACTION

Reissue Applications

1. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Defective Reissue Oath/Declaration

Following are extracted paragraphs from the MPEP:

The provisions of 35 U.S.C. 251 permit the reissue of a patent to correct an error in the patent made without any deceptive intention and provide criteria for the reissue. 37 CFR 1.171 through 1.179 are rules directed to reissue.

1402 Grounds for Filing

A reissue application is filed to correct an error in the patent which was made without any deceptive intention, where, as a result of the error, the patent is deemed wholly or partly inoperative or invalid. An error in the patent arises out of an error in conduct which was made in the preparation and/or prosecution of the application which became the patent. There must be at least one error in the patent to provide grounds for reissue of the patent. If there is no error in the patent, the patent will not be reissued. The present section provides a discussion of what may be considered an error in the patent upon which to base a reissue application.

In accordance with 35 U.S.C. 251, the error upon which a reissue is based must be one which causes the patent to be "deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent." Thus, an error under 35 U.S.C. 251 has not been presented where the correction to the patent is one of spelling, or grammar, or a typographical, editorial or clerical error which does not cause the patent to be deemed wholly or partly inoperative or invalid for the reasons specified in 35 U.S.C. 251. These corrections to a patent do not provide a basis for reissue (although these corrections may

Art Unit: 2746

also be included in a reissue application, where a 35 U.S.C. 251 error is already present). These corrections may be made via a certificate of correction; see MPEP § 1481.

The most common bases for filing a reissue application are:

- (A) the claims are too narrow or too broad;
- (B) the disclosure contains inaccuracies;
- © applicant failed to or incorrectly claimed foreign priority; and
- (D) applicant failed to make reference to or incorrectly made reference to prior copending applications.

An attorney's failure to appreciate the full scope of the invention was held to be an error correctable through reissue in *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). The correction of misjoinder of inventors in divisional reissues has been held to be a ground for reissue. See *Ex parte Scudder*, 169 USPQ 814 (Bd. App. 1971). The Board of Appeals held in *Ex parte Scudder*, 169 USPQ at 815, that 35 U.S.C. 251 authorizes reissue application to correct misjoinder of inventors where 35 U.S.C. 256 is inadequate.

2. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based.

See 37 CFR 1.175(a)(1) and MPEP § 1414 (see the following inserted paragraphs).

II. A STATEMENT OF AT LEAST ONE ERROR WHICH IS RELIED UPON TO SUPPORT THE REISSUE APPLICATION (I.E., THE BASIS FOR THE REISSUE).

A reissue applicant must acknowledge the existence of an error in the specification, drawings, or claims, which error causes the original patent to be defective. In *re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). A change or departure from the original specification or claims represents an "error" in the original patent under 35 U.S.C. 251. See MPEP § 1402 for a discussion of grounds for filing a reissue that may constitute the "error" required by 35 U.S.C. 251. Not all changes with respect to the patent constitute the "error" required by 35 U.S.C. 251.

Applicant need only specify in the reissue oath/declaration one of the errors upon which reissue is based. Where applicant specifies one such error, this requirement of a reissue oath/declaration is satisfied. Applicant may specify more than one error. Where more than one error is specified in the oath/declaration and some of the

Art Unit: 2746

designated "errors" are found to not be "errors" under 35 U.S.C. 251, any remaining error which is an error under 35 U.S.C. 251 will still support the reissue.

The "at least one error" which is relied upon to support the reissue application must be set forth in the oath/declaration. It is not necessary, however, to point out how (or when) the error arose or occurred. Further, it is not necessary to point out how (or when) the error was discovered. If an applicant chooses to point out these matters, the statements directed to these matters will not be reviewed by the examiner, and the applicant should be so informed in the next Office action. All that is needed for the oath/declaration statement as to error is the identification of "at least one error" relied upon.

In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid. The corresponding corrective action which has been taken to correct the original patent need not be identified in the oath/declaration. If the initial reissue oath/declaration "states at least one error" in the original patent, and, in addition, recites the specific corrective action taken in the reissue application, the oath/declaration would be considered acceptable, even though the corrective action statement is not required.

It is not sufficient for an oath/declaration to merely state "this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure." Rather, the oath/declaration must specifically identify an error. In addition, it is not sufficient to merely reproduce the claims with brackets and underlining and state that such will identify the error. See *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), cert. denied, 484 U.S. 894 (1987). Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error.

In the Oath and Declaration, the Applicant claims an error occurs in both claims 1 and 10; however, the Applicant did not amend claims 1 and 10, but instead adding new claims 19-138 without addressing clearly how the error could be fixed or revised.

Art Unit: 2746

3. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-138 are rejected as being based upon a defective oath & declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Specification

4. The disclosure is objected to because of the following informalities: The specifications should have a single column, not double.

Appropriate correction is required. A new specification is needed.

5. Claims 19-138 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Art Unit: 2746

6. Claims 19-138 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. .

Regarding new claims 19-138, the specification fails to provide an enabling on how a (meaning single) server satellite can receive mission data from a client, irrespective of its location on earth. The specification states or declares a plurality of server satellites instead.

7. The amendment filed on 11/14/01 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: a (meaning single) server satellite can receive mission data from a client, irrespective of its location on earth.

Applicant is required to cancel the new matter in the reply to this Office Action.

Art Unit: 2746

Drawings

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “airborne platform” of claim 70, the “exo-atmospheric platform” of claim 71, and the earth station comprises “an airborne platform” of claim 77 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Hickman (US Patent 6,173,332 B1) and Kane et al (US Patent 6,088,571) disclose communication satellite with on-earth servers. Armbruster et al (US Patent 5,920,804) and Vanden Heuvel et al (US Patent 5,924,014) disclose method for handoff and routing between multiple satellite systems. Wiedeman (US Patent 5,867,109) discloses satellite repeater diversity resource management system. Horstein et al. (US Patent 5,867,783) disclose medium-earth-altitude satellite based cellular telecommunications. Kimura et al. (US Patent 5,722,042) disclose a satellite communication system having double layered earth orbit satellite constellation with two different altitudes.

Art Unit: 2746

10. **Any response to this action should be mailed to:**
Commissioner of Patents and Trademarks
Washington, D.C. 20231


or faxed to:
(703) 872-9314, (for Technology Center 2600 only)

*Hand-delivered responses should be brought to Crystal Park II,
2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tony Thuan Nguyen whose telephone number is (703) 308-5860. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:00 PM, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Hunter, can be reached at (703) 308-6732.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600 Customer Service Office** whose telephone number is **(703) 306-0377**.


DANIEL HUNTER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Tony T. Nguyen
Art Unit 2684
December 05, 2002